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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,783

07/02/2003

Thomas J. La Rosa

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MONSANTO COMPANY

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ST. LOUIS, MO 63167

EXAMINER

BUI, PHUONG T

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

03/01/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,783	Applicant(s) LA ROSA ET AL.	
	Examiner Phuong T. Bui	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Office acknowledges the receipt of Applicant's amendment filed October 29, 2009. Claims 1, 2 and 9-13 are pending and are examined in the instant application.

All previous rejections not set forth below have been withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Since SEQ ID NO:3366 was first disclosed in the instant application, Applicant date of priority benefit is July 2, 2003.

This action is made FINAL.

Double Patenting

2. Claims 1, 2 and 9-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 5, 7, 9-13, 20-29, 34 and 38 (previously indicated as claims 1-2) of copending Application No. 11/980366. Although the conflicting claims are not identical, they are not patentably distinct from each other because SEQ ID NOs:3366 and 6915 of the instant application are the same as SEQ ID NOs:3366 and 6915 of the copending application. The plant host containing said sequences is not patentably distinct from the sequences. If canceled claims 1-2 were presented together with pending claims 4, 5, 7, 9-13, 20-29, 34 and 38 in the pending application, they would have been grouped together as one invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

3. Claims 1, 2 and 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a substantial, specific asserted utility or a well established utility. This rejection is maintained for reasons of record.

Applicant traverses primarily that the law allows Applicant to provide more than one utility for the claimed invention.

Applicant's traversals have been considered but are deemed unpersuasive because Applicant does not provide a substantial, specific utility for SEQ ID NO:3366. Applicant does not indicate which from the laundry list of all possible utilities for all plant genes would be specific to SEQ ID NO:3366. While Applicant may list more than one utility for SEQ ID NO:3366, no utility for SEQ ID NO:3366 is disclosed. Listing all possible plant gene functions and inviting one skilled in the art to determine which is applicable to SEQ ID NO:3366 among the 12,046 sequences disclosed does not meet the utility requirements under current utility guidelines. Accordingly, this rejection is maintained.

Claim Rejections - 35 USC § 112, first paragraph

4. Claims 1, 2 and 9-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial, specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. Further, with regard to claims 9-12, these claims are further not enabled because they encompass unspecified

base substitutions, deletions, additions, and/or combinations thereof without any recitation of function. This rejection is maintained for reasons of record.

Applicant traverses primarily that SEQ ID NO:3336 has a high degree of homology to a cytochrome P450 which can be used to prepare antibodies, transform plants and modify protein expression, and any modifications to the claimed sequences would be readily apparent to one skilled in the art.

Applicant's traversals have been considered but are deemed unpersuasive because Applicant's arguments are not commensurate in scope with the claims. With regard to lacking enablement because the claimed invention lacks utility, this issue has been addressed in the utility rejection above. While one skilled in the art can make antibodies, transform plants and modify protein expression for all gene sequences, it is unclear what benefits would be obtained by doing so with SEQ ID NO:3336. With regard to modifications within the 90-99% sequence identity, it is unclear which modifications are of benefit to one skilled in the art, as no function is set forth for the modified sequences. Accordingly, this rejection is maintained.

Claim Rejections - 35 USC § 102

5. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Kikuchi et al. (US20060123505, filed May 29, 2003, see sequence alignment in Kikuchi et al., Database Published_Applications_NA_Main, US20060123505, SEQ ID NO:16522, see search result 2 (previously cited)). Kikuchi teaches a sequence of SEQ ID NO:16522 which has 90% sequence identity to SEQ ID NO:3366. Thus, Kikuchi anticipated the claimed invention.

The amendment to claim 9 does not obviate this rejection. Accordingly, this rejection is maintained.

Remarks

6. No claim is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Bui whose telephone number is 571-272-0793.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1638

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phuong T. Bui/
Primary Examiner, Art Unit 1638